

REMARKS

Claims 4-33 were pending in this application. Claims 14-33 are canceled without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in one or more continuing applications. New claim 34 has been added. Support for the new claim may be found throughout the specification and claims as originally filed, for example, in claim 14 as filed and/or page 22, lines 9-19. Claims 4, 5, 7, 8, 12, and 13 have been amended predominantly to correct matters of form. No new matter is introduced by these claim amendments.

After entry of this Amendment, **claims 4-13 and 34-36 are pending in this application.** Consideration of the pending claims is requested.

Restriction Requirement

The Office contends that the pending claims are directed to four “distinct” inventions and has required restriction to one alleged invention under 35 U.S.C. 121. The four Groups provided by the Office are:

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| Group I (claims 5, 6, and 7) | drawn to a method of detecting Pin1 comprising contacting a cell with nucleotide comprising SEQ ID NO: 1; |
| Group II (claim 8) | drawn to a method of detecting Pin1 comprising contacting a cell with an antibody; |
| Group III (claim 15, 16, and 17) | drawn to a method of detecting a cell proliferative disorder comprising contacting a cell with nucleotide comprising SEQ ID NO: 1; and |
| Group IV (claim 18) | drawn to a method of detecting a cell proliferative disorder comprising contacting a cell with an antibody. |

The Office asserts that claims 4 and 9-13 link the methods of Groups I and II, and claims 14 and 19-33 link the methods of Group III and IV. Accordingly, upon allowance of a linking claim, the restriction requirement as to linked Groups will be withdrawn and any claims depending from or otherwise including all of the limitations of the allowable linking claim will be entitled to examination.

The Office has further issued species elections. Upon election of either Group I or II, Applicants must elect one of “the different cancers listed in claim 13.” While, upon election of either Group III or IV, Applicants must elect “the changes in Pin amount characterized by [A-E as set forth on page 3 of the Office action.]”

Applicants traverse the restriction requirement and the species elections.

With regard to the restriction requirement, Applicants respectfully submit that a search for methods of detecting Pin1 (whether with the specified nucleotide or antibody) in a cell sample (*i.e.*, claims of Groups I or II) will necessarily uncover prior art concerning the detection of Pin1 in any cell type, including hyperproliferative cells. Thus, a search for methods of detecting Pin1 (*i.e.*, claims of Groups I or II) will inevitably reveal prior art related to methods of detecting a cell proliferative disorder (*i.e.*, claims of Groups III or IV). Accordingly, there is no undue burden to search Groups I-IV together or to search together, at least, Groups I and III or Groups II and IV. Nevertheless, merely to facilitate prosecution of the application, the claims of Groups III and IV (drawn to methods of detecting a cell proliferative disorder) have been canceled without prejudice to pursuit of such subject matter in one or more other application(s).

With regard to the species election associated with election of either Group I or II, Applicants urge that designating a particular type of cancer in which Pin1 is to be detected will not noticeably affect the prior art search for the claims of Group I or II. The claims of such Groups recite methods of detecting Pin1 in any cell sample (not merely cancer cells). Moreover, for the subset of Group I or II claims relating to detection of Pin1 in a cancer, a search for “Pin1 and cancer” would impose no more serious a search burden than would a search for Pin1 and an elected species of cancer. Accordingly, Applicants politely ask the Examiner to withdraw the species election related to Groups I or II.

To be fully responsive, Applicants provisionally elect the claims of Group II (drawn to a method of detecting Pin1 comprising contacting a cell sample with an antibody). Such election is made pending the allowance of a claim linking the claims of Groups I and II, at which time the

claims of Group I will also be examined. Applicants further provisionally elect "breast cancer" as the species of cancer to be examined.

CONCLUSION

Substantive examination of the pending claims is respectfully requested. The Examiner is invited to call the undersigned if the Examiner believes that a telephone interview would facilitate substantive examination of this application.

Respectfully submitted,

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